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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,319	04/20/2001	Tomoya Saeki	Q64153	1014

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/838,319

Applicant(s)

SAEKI, TOMOYA

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is responsive to the amendment filed on April 9, 2004.

### ***Response to Arguments***

2. Applicant's arguments, see pages 20-24, filed April 9, 2004, with respect to the rejection(s) of claim(s) 1, 15 and 29 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art, US Publication No. 2001/0039535 to Tsiounis et al.

Tsiounis et al. disclose a database (i.e. "PAN server database") for settling account information required to process charges and an authentication server (i.e. "TTP") having a function of processing charges based on said settling account information registered in said database (see paragraph [0047] and [0052]). Tsiounis et al.'s system includes a customer, merchant and trusted third party (TTP). The trusted third party comprises a payment authorization number server (PAN server), payment transaction server (PT server), transaction processor and one or more databases (see paragraph [0053]). Notice, paragraph [0047] recites:

The PAN calculator saves the encrypted data and transaction information in the PAN server database (step 250) so as to keep record of the customer's confidential payment information.

The PAN server database, which is a component of the TTP stores "customer's confidential payment information", which is interpreted as settling account information required to process charges.

In terms of processing charges based on said settling account information registered in said database, Tsiounis et al. clearly disclose this process. The TTP of Tsiounis et al.'s system authenticates the PAN, 'verifies the customer's confidential payment information by checking, for example, whether the cards used by the customer to create the signature were valid and had not expired, **there are sufficient funds in the account**, and the merchant accepts this method of payment. If the transaction information passes the proper validations, **TTP authorizes payment and executes payment to the merchant**" (see paragraph [0052]).

3. Claims 1-45 have been examined.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-17, 19-31, and 33-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2003/0204610 to Howard et al. in view of US Publication No. 2001/0039535 to Tsiounis et al.

Referring to claims 1,15 and 29, Howard et al. disclose the system has a database for storing at least personal authentication data required for said personal authentication and previously registered, and data required to receive various services (see paragraphs [0018] and [0029]), said authentication server has a function of collating said authentication information input from said authentication terminal via said communication terminal, against said personal authentication data stored in said database, said authentication terminal when the client is authenticated during said identification, and a function of providing, registering, and managing personal data registered beforehand in said database based on a request forms aid authentication terminal when the client is authenticated during said identification and periodically communicating a collation history, a personal data usage history, and a charge process history, i.e. cookie (see abstract, lines 11-14,21-25). Howard et al. do not expressly disclose a database storing settling account information required to process charges or an authentication server has a function of processing charges based on said settling account information registered in said database based on a request. Tsiounis et al. disclose a database ("PAN server database") storing settling account information (i.e. "customer's confidential payment information"), required to process charges (see paragraph [0047]) and an authentication server (i.e. "TTP") has a function of processing charges based on said settling account information registered in said database based on a request. One of ordinary skill in the art would have been motivated to do this because the database organizes and stores the data in a manner in which the authentication server can easily retrieve the necessary information for authentication and authorization.

Referring to claims 2, 16 and 30, Howard et al. disclose the system wherein said authentication server includes a function of communicating permission for said various services

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based on a request from said authentication terminal when the client is authenticated during said identification (see paragraphs [0019] and [0032]).

Referring to claims 3, 17, and 31, Howard et al. disclose the system wherein said personal authentication data are at least one of the client's fingerprint, the client's voiceprint, the client's iris pattern, and a preset password (see paragraph [0029]).

Referring to claims 5, 19 and 33, Howard et al. disclose the function of communicating said collation history, said personal data usage history, and said charge process history is configured to show these information on a home page (see paragraph [0044]).

Referring to claims 6, 20 and 34, Howard et al. disclose the system wherein only previously registered clients are allowed to view said home page (see paragraph [0029]).

Referring to claims 7, 21 and 35, Howard et al. disclose a personal authentication system including an authentication terminal. Howard et al. do not expressly disclose the authentication terminal is installed in a store and is configured to request said authentication server to execute said identification when at least one of a commodity and a service is to be provided and to request said authentication server to pay a consideration for the provided commodity and service from said settling account when the client is authenticate during said identification. Tsiounis et al. disclose the authentication terminal is installed in a store and is configured to request said authentication server to execute said identification when at least one of a commodity and a service is to be provided and to request said authentication server to pay a consideration for the provided commodity and service from said settling account when the client is authenticate during said identification (see paragraph [0100]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard et

al. to include the authentication terminal at a store. One of ordinary skill in the art would have been motivated to do this because it performs verification; thus, reducing fraud and disputes.

Referring to claims 43-45, Howard et al. disclose personal authentication data (see claim 1 above). Howard et al. do not expressly disclose the personal authentication data comprises at least one of the client's fingerprint, the client's voiceprint, and the client's iris pattern. However, this difference is only found in the nonfunctional descriptive material and is not functionally in the step recited. The storing at least personal authentication data required for said personal authentication would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store at least personal authentication data required for said personal authentication, the personal authentication data comprising any type of content, because such data does not functionally relate to the steps in the method claimed.

6. Claims 8-14, 22-28 and 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. and Tsiounis et al. as applied to claim 1 above, and further in view of US Publication No. 2003/0212642 to Weller et al.

Howard et al. discloses a personal authentication system including an authentication terminal (see claim 1 above). Howard et al. do not expressly disclose the authentication terminal installed at a ticket gate of a public transportation facility, hospital clerk's window, government officer's window, in various service-providing facilities, an entrance or exit of a facility, a

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window where a certificate is issued or added to a public telephone, configured to request said authentication server to execute said identification and pay for the services from said settling account. Wheeler et al. disclose the authentication terminal installed at a ticket gate of a public transportation facility, hospital clerk's window, government officer's window, in various service-providing facilities, an entrance or exit of a facility, a window where a certificate is issued and added to a public telephone, configured to request said authentication server to execute said identification and pay for the services from said settling account (see paragraphs [0032] and [0033]). Notice, "PAS can also be used in aspects of **retail banking** such as debit cards, purchase cards, stored value cards, as well as wholesale banking, **the medical business**, the insurance business, the brokerage business, **etc.** ID cards can also used with PAS. For example, **AAA** may use PAS to authenticate the identity of its customer, or **telephone card company** can use PAS to authenticate the identity of the user of a specific card" (see paragraph [0033], lines 20-27). Thus, this implies that the authentication terminal may be installed in any facility including a ticket gate of a public transportation facility, a public telephone, hospital clerk's window, a government officer's window, an entrance or exit of a facility, a window where a certificate is issued and in various service-providing facilities. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard et al. to include the authentication terminal installed at a ticket gate of a public transportation facility, hospital clerk's window, government officer's window, an entrance or exit of a facility, a window where a certificate is issued, in various service-providing facilities or added to a public telephone, configured to request said authentication server to execute said identification and pay for the services from said settling account. One of ordinary



skill in the art would have been motivated to do this because it performs verification; thus, reducing fraud and disputes (see [0005]).

7. Claims 4, 18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. as applied to claims 1, 15 and 29 respectively above, and further in view of U.S. Publication No. 2002/0120496 to Scroggie et al.

Howard et al. disclose communicating said collation history, said personal data usage history, and said charge process history (see Abstract, lines 11-14, 21-25). Howard et al. do not expressly disclose the function of communicating is configured to communicate this information by electronic mail. Scroggie et al. disclose transmitting email messages to consumers based on purchase history information stored in the consumers' database (see paragraph [0110]). Notice, the examiner interprets the purchase history information as "collation history, personal data usage history and charge process history". At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Howard et al. such that the function of communicating is configured to communicate this information by electronic mail. One of ordinary skill in the art would have been motivated to do this because it an easy and quick method of transmitting data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
PO Box 1450  
Alexandria, VA 22313-1450***

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

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June 28, 2004

  
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